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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/797,782   | 03/09/2004  | Shelah Phillips      | PECL-0011           | 4143             |
| 23377  | 7590        | 09/15/2005           | EXAMINER            |                  |
| WOODCOCK WASHBURN LLP<br>ONE LIBERTY PLACE, 46TH FLOOR<br>1650 MARKET STREET<br>PHILADELPHIA, PA 19103 |             |                      | STORMER, RUSSELL D  |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 3617                |                  |

DATE MAILED: 09/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                                |                  |
|------------------------------|--------------------------------|------------------|
| <b>Office Action Summary</b> | Application No.                | Applicant(s)     |
|                              | 10/797,782                     | PHILLIPS, SHELAH |
|                              | Examiner<br>Russell D. Stormer | Art Unit<br>3617 |

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 08 July 2005.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-3,5,8-14,16 and 19-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-3,5,8-14,16 and 19-22 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date: _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date: _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____                                    |

***Claim Objections***

1. Claims 10 and 20 are objected to because of the following informalities:

The phrase "in fact" used twice in each of these claims is objected to as indefinite and unnecessary. The phrase should simply be deleted from the claims.

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 2, 3, 5, 8-11, 13, 14, 16, and 19-21 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Oba et al (previously cited by Applicant; newly applied).

See especially figures 1-3 which show the inner and outer radial faces, the recess which receives the clip, the serration 33 and the flowed lateral sides of the weight body.

With respect to claims 3 and 14, the weight body is not shown to be arcuate, but in lines 27-31 of column 2 and lines 42-44 of column 4, the weight body is described as being arcuate to contact the rim flange of the wheel.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 12 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oba et al.

Oba et al discloses a radially extending portion 30c on the clip which includes recesses or serrations 33a, and engages the first guiding portion 16 of the weight. The material of the weight body is caulked into the serrations.. Only one serration is shown on each side of the radially extending portion of the clip.

Those of ordinary skill in the art would have found it obvious to provide a plurality of serrations 33a in the side of the clip of Oba et al as this is merely a multiplication of parts, and the result of providing better gripping of the weight by the clip is predictable.

***Response to Arguments***

6. Applicant's arguments with respect to claims 1-3, 5, 8-14, 16, and 19-22 have been considered but are moot in view of the new grounds of rejection.

***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The references show additional wheel balancing weights.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Russell D. Stormer whose telephone number is (571) 272-6687. The examiner can normally be reached on Monday through Friday, 9 AM to 4 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joe Morano can be reached on (571) 272-6684. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

9/12/05

  
RUSSELL D. STORMER 9/12/05  
PRIMARY EXAMINER 9/12/05